

ESTTA Tracking number: **ESTTA457972**

Filing date: **02/22/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Redbox Automated Retail, LLC
Granted to Date of previous extension	02/22/2012
Address	One Tower Lane, Suite 1200 Oakbrook Terrace, IL 60181 UNITED STATES
Attorney information	James P. Muraff Neal, Gerber & Eisenberg LLP 2 North LaSalle Street Suite 1700 Chicago, IL 60602 UNITED STATES jmuraff@ngelaw.com, mhall@ngelaw.com, khinner@ngelaw.com

Applicant Information

Application No	85212993	Publication date	10/25/2011
Opposition Filing Date	02/22/2012	Opposition Period Ends	02/22/2012
Applicant	Hapa AG Chriesbaumstrasse 4 Volketswil, 8604 SWITZERLAND		

Goods/Services Affected by Opposition

Class 002. All goods and services in the class are opposed, namely: Printing ink and ink toner for printing machines; filled color ink cartridges and filled printing ink cartridges for printing machines
Class 007. All goods and services in the class are opposed, namely: Printing machines and automatic industrial labeling machines for applying labels to containers and bottles
Class 009. All goods and services in the class are opposed, namely: Printers for use with computers and computer software for operating printers; apparatus for data processing, computer hardware and software for the marking and coding of packages


Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	2919854	Application Date	01/08/2003
Registration Date	01/18/2005	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31 VENDING MACHINES		

U.S. Registration No.	2988869	Application Date	01/08/2003
Registration Date	08/30/2005	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31 Automated DVD rental services		

U.S. Registration No.	3082012	Application Date	11/10/2004
Registration Date	04/18/2006	Foreign Priority Date	NONE
Word Mark	REDBOX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2003/03/31 First Use In Commerce: 2003/03/31 VENDING SERVICES, NAMELY, PROVIDING RETAIL FACILITIES FEATURING AUTOMATED DVD RENTAL		

U.S. Registration No.	3229436	Application Date	04/20/2006
Registration Date	04/17/2007	Foreign Priority Date	NONE
Word Mark	REDBOX		

Design Mark	
Description of Mark	The mark consists of the word "redbox" with an arc over the word.
Goods/Services	Class 009. First use: First Use: 2004/05/00 First Use In Commerce: 2004/05/00 Vending machines Class 041. First use: First Use: 2004/05/00 First Use In Commerce: 2004/05/00 Rental of pre-recorded DVDs on a variety of subjects through automated vending machines

U.S. Registration No.	3300349	Application Date	04/20/2006
Registration Date	09/25/2007	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a 3-dimensional cube with rounded edges.		
Goods/Services	Class 041. First use: First Use: 2005/06/00 First Use In Commerce: 2005/06/00 Rental of DVDs featuring entertainment content through automated vending machines		

Attachments	78514282#TMSN.jpeg (1 page)(bytes) 78866011#TMSN.jpeg (1 page)(bytes) 78865999#TMSN.jpeg (1 page)(bytes) REDCUBE opposition.pdf (12 pages)(440908 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/James P. Muraff/
Name	James P. Muraff
Date	02/22/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application)	
Serial No.: 85212993)	
)	
Published in the Official Gazette)	
On October 15, 2011)	
)	
REDBOX AUTOMATED RETAIL, LLC)	
)	
Opposer,)	NOTICE OF OPPOSITION
v.)	
)	
Hapa AG)	
)	
Applicant.)	

This Notice of Opposition is submitted in the matter of Application Serial No. 85212993, for registration by Hapa AG, of the term REDCUBE (Design) based upon their intent to use that term in connection with “colors; printing ink and ink toner for printing machines; color cartridges and printing ink cartridges for printing machines” in International Class 2, “printing machines and labellers machines” in International Class 7, and “printers for use with computers and software for printers for use with computers; apparatus for data processing, computer hard and software, in particular for the marking and coding of packages; parts and accessories not included in other classes for all the aforementioned goods” in International Class 9, which was published for opposition in the Official Gazette on October 15, 2011. Redbox Automated Retail, LLC, a Delaware Limited Liability Company having a place of business at One Tower Lane, Oakbrook Terrace, Illinois 60181, believes that it would be damaged by the registration and therefore opposes the same.

Notice of Opposition

The grounds for Opposition herein are as follows:

1. Redbox Automated Retail, LLC, is a vendor of automated DVD rental services through automated kiosks. Opposer has more than 30,000 locations nationwide and has serviced over 50 million different customers. Opposer has REDBOX automated kiosks located across the United States in Quick Service Restaurants (QSR), pharmacies, grocery stores, discount stores, convenience stores, train stations, airports, and other locations.

2. For many years, and before the acts of Applicant alleged herein, Opposer has provided automated DVD rental services under and in connection with its REDBOX and CUBE trademarks and trade name, establishing both common law rights as well as rights under the Lanham Act. Indeed, Opposer has devoted significant resources, time and effort to marketing and promoting its automated DVD rental services under the REDBOX and CUBE trademark and trade name. Opposer maintains a website under the domain name www.redbox.com, which is available to all members of the trade and public, and which promotes its REDBOX kiosks and showcases its services. As a result, Opposer's REDBOX trademark and CUBE have become famous in the United States.

3. As a result of the foregoing, Opposer has obtained a registration for the trademark REDBOX for use in connection with at least automated DVD rental services, etc., including Registration Nos. 2919854, 2988869, 3082012 and 3229436, among others. Opposer also obtained a registration for the trademark CUBE for use in connection with rental of DVDs featuring entertainment content through automated vending machines, including Registration No. 3300349. Copies of the Trademark Registrations are attached hereto as Exhibit A. Opposer's REDBOX and CUBE trademarks, and the registrations therefore, are now among its most valuable assets.

Notice of Opposition

5. On January 7, 2011, long after Opposer began use of its REDBOX and CUBE trademarks, Applicant filed an application to register REDCUBE (& Design) based upon use in connection with “colors; printing ink and ink toner for printing machines; color cartridges and printing ink cartridges for printing machines” in International Class 2, “printing machines and labellers machines” in International Class 7, and “printers for use with computers and software for printers for use with computers; apparatus for data processing, computer hard and software, in particular for the marking and coding of packages; parts and accessories not included in other classes for all the aforementioned goods” in International Class 9.

6. Applicant’s use and registration of the term REDCUBE (& Design) as a trademark is likely to cause confusion or mistake, or to deceive purchasers, in that purchasers would be likely to believe Applicant’s services are Opposer’s services, or are in some way legitimately connected with, sponsored by, or approved by Opposer in violation of 15 U.S.C. § 1052(d). Additionally, Applicant’s use of the term REDCUBE (& Design) would dilute Opposer’s distinctive, famous, and valuable REDBOX and CUBE trademark in violation of 15 U.S.C. § 1125(c). Applicant’s registration of the term REDCUBE (& Design) would, therefore, damage Opposer, and on that basis, Opposer opposes registration of the term REDCUBE (& Design) by Applicant.

WHEREFORE, Opposer requests that the registration sought by Applicant be refused and that this Notice of Opposition be sustained.

Notice of Opposition

Opposer requests that the requisite filing fee of \$300.00 be charged to the deposit account of Neal, Gerber & Eisenberg, LLP, Account No. 502261.

Respectfully submitted,

Date: February 22, 2012

By: /James P. Muraff /
James P. Muraff
One of the Attorneys for
Redbox Automated Retail, LLC
Neal, Gerber & Eisenberg LLP
Two North LaSalle Street
Chicago, Illinois 60602-3801
(312) 269-8000 (telephone)
(312) 269-1747 (fax)

CERTIFICATE OF TRANSMISSION

I, James P. Muraff, hereby certify that the foregoing *Notice of Opposition* is being electronically transmitted via the Electronic System for Trademark Trials and Appeals (“ESTTA”) at <http://estta.uspto.gov/> on the date noted below:

Date: February 22, 2012

By: / James P. Muraff/
Attorney for Redbox Automated Retail, LLC
James P. Muraff
Neal, Gerber & Eisenberg LLP
Two North LaSalle Street, Suite 1700
Chicago, Illinois 60602-3801
(312) 269-8000

CERTIFICATE OF SERVICE

I, James P. Muraff, an attorney, state that, pursuant to 37 CFR §§ 2.101 and 2.119, I caused a true and correct copy of the foregoing Notice of Opposition to be served upon:

Lawrence E. Abelman
Abelman Frayne & Schwab
10th Floor
666 Third Avenue
New York NY 10017

via First Class Mail postage prepaid on February 22, 2012.

/James P. Muraff /
James P. Muraff

NGEDOCs: 1877172.1

EXHIBIT A

Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

Reg. No. 2,988,869

United States Patent and Trademark Office

Registered Aug. 30, 2005

**SERVICE MARK
PRINCIPAL REGISTER**

REDBOX

FUTURE PROPERTY MANAGEMENT, INC. (DE-
LAWARE CORPORATION)
1013 CENTRE ROAD
WILMINGTON, DE 19805

FIRST USE 3-31-2003; IN COMMERCE 3-31-2003.

SER. NO. 78-201,199, FILED 1-8-2003.

FOR: AUTOMATED DVD RENTAL SERVICES, IN
CLASS 41 (U.S. CLS. 100, 101 AND 107).

BARBARA GAYNOR, EXAMINING ATTORNEY

Int. Cl.: 9

Prior U.S. Cls.: 21, 23, 26, 36, and 38

Reg. No. 2,919,854

United States Patent and Trademark Office

Registered Jan. 18, 2005

**TRADEMARK
PRINCIPAL REGISTER**

REDBOX

FUTURE PROPERTY MANAGEMENT, INC. (DE-
LAWARE CORPORATION)
1013 CENTRE ROAD
WILMINGTON, DE 19805

FIRST USE 3-31-2003; IN COMMERCE 3-31-2003.

SN 78-201,219, FILED 1-8-2003.

FOR: VENDING MACHINES, IN CLASS 9 (U.S.
CLS. 21, 23, 26, 36 AND 38).

JENNIFER CHICOSKI, EXAMINING ATTORNEY

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 3,082,012

United States Patent and Trademark Office

Registered Apr. 18, 2006

**SERVICE MARK
PRINCIPAL REGISTER**

REDBOX

REDBOX AUTOMATED RETAIL, LLC (DELA-
WARE CORPORATION)
ONE MCDONALD'S PLAZA
OAK BROOK, IL 60523

FOR: VENDING SERVICES, NAMELY, PROVID-
ING RETAIL FACILITIES FEATURING AUTOMA-
TED DVD RENTAL, IN CLASS 35 (U.S. CLS. 100, 101
AND 102).

FIRST USE 3-31-2003; IN COMMERCE 3-31-2003.

THE MARK CONSISTS OF STANDARD CHAR-
ACTERS WITHOUT CLAIM TO ANY PARTICULAR
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 2,919,854.

SER. NO. 78-514,282, FILED 11-10-2004.

CAROLINE WOOD, EXAMINING ATTORNEY

Int. Cls.: 9 and 41

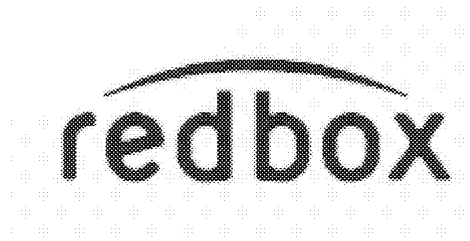
Prior U.S. Cls.: 21, 23, 26, 36, 38, 100, 101 and 107

United States Patent and Trademark Office

Reg. No. 3,229,436

Registered Apr. 17, 2007

**TRADEMARK
SERVICE MARK
PRINCIPAL REGISTER**



REDBOX AUTOMATED RETAIL, LLC (DELA-
WARE LTD LIAB CO)
ONE TOWER LANE, SUITE 1200
OAKBROOK TERRACE, IL 60181

FOR: VENDING MACHINES, IN CLASS 9 (U.S.
CLS. 21, 23, 26, 36 AND 38).

FIRST USE 5-0-2004; IN COMMERCE 5-0-2004.

FOR: RENTAL OF PRE-RECORDED DVDS ON A
VARIETY OF SUBJECTS THROUGH AUTOMATED
VENDING MACHINES, IN CLASS 41 (U.S. CLS. 100,
101 AND 107).

FIRST USE 5-0-2004; IN COMMERCE 5-0-2004.

OWNER OF U.S. REG. NOS. 2,919,854, 2,988,869,
AND 3,082,012.

THE MARK CONSISTS OF THE WORD "RED-
BOX" WITH AN ARC OVER THE WORD.

SER. NO. 78-866,011, FILED 4-20-2006.

GINA HAYES, EXAMINING ATTORNEY

Int. Cl.: 41

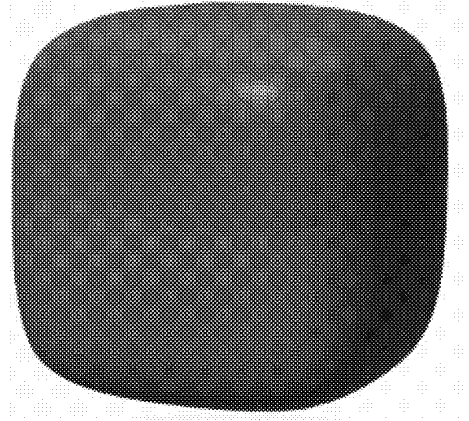
Prior U.S. Cls.: 100, 101, and 107

United States Patent and Trademark Office

Reg. No. 3,300,349

Registered Sep. 25, 2007

**SERVICE MARK
SUPPLEMENTAL REGISTER**



REDBOX AUTOMATED RETAIL, LLC (DELA-
WARE LTD LIAB CO)
ONE TOWER LANE, SUITE 1200
OAKBROOK TERRACE, IL 60181

FOR: RENTAL OF DVDS FEATURING ENTER-
TAINMENT CONTENT THROUGH AUTOMATED
VENDING MACHINES, IN CLASS 41 (U.S. CLS. 100,
101 AND 107).

FIRST USE 6-0-2005; IN COMMERCE 6-0-2005.

THE MARK CONSISTS OF A 3-DIMENSIONAL
CUBE WITH ROUNDED EDGES.

SER. NO. 78-865,999, FILED P.R. 4-20-2006; AM. S.R.
6-27-2007.

GINA HAYES, EXAMINING ATTORNEY